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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,534	06/23/2000	Ariel Cattani	Q59789	1185

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EXAMINER

MARCELO, MELVIN C

ART UNIT	PAPER NUMBER
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2662

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,534

Applicant(s)

CATTAN ET AL.

Examiner

Melvin Marcelo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-25 and 27-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 6-11,14-21,32,34-37 and 39-41 is/are allowed.
6) ☒ Claim(s) 1-4,22-25 are 38 is/are rejected.
7) ☒ Claim(s) 12,13,27-31,33 and 42 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note the objections to the original drawings in the Notice of Draftsperson's Patent Drawing Review included in the Office Action mailed 03-04-2004.

Response to Arguments

2. Applicant's arguments with respect to claims 1-4 and 22-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claims 12, 13, 33 and 42 are objected to because of the following informalities:

In claim 12, line 6, the phrase --of the first upstream Internet message-- should be added after "address" in order to explicitly clarify the basis for "the first upstream identification and the first upstream Internet address."

In claim 13, applicant's previous changes to the claim appears to have a typographical error which deleted "responsive" in line 8 ("first responsive mobile terminal

message data”), instead of line 11 (“first responsive Internet address”). See applicant’s remarks concerning claims 13 and 16.

In claim 22, line 9, “corresponding to the” should be deleted since it appears twice in a row.

In claim 33, the changes made to claim 12 should also be made to this claim, wherein in lines 1-2, “first downstream Internet address” should be --the first downstream Internet message--; in lines 2-3, “a first selected Internet address” should be --a first downstream Internet address--; in line 7, --of the first upstream Internet message-- should be inserted after “address”; and in line 8, “the first selected Internet address” should be --the first downstream Internet address--. See applicant’s remarks concerning claim 12.

In claim 42, line 9, “corresponding to the” should be deleted since it appears twice in a row.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38 lacks a proper antecedent basis to claim 13. Newly added claim 38 appears to correspond to the limitations added to claim 1. However, claim 1 limitations include “a first upstream mobile terminal message,” “selects a first upstream Internet address” and “a first upstream Internet message.” In contrast, claim 13 limitations

include "a first responsive upstream mobile terminal message" in which it is not apparent that it would be the basis for "the first upstream mobile terminal message" in lines 1-2, and does not include any recitations directed to "upstream Internet" addresses or messages (instead claim 13 recites "downstream Internet" addresses and messages).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-4 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kotola et al. (US 6,321,257 B1).

With respect to the claims below, references to the prior art appear in parenthesis.

1. *(currently amended): A communication system (Kotola, Figures 1 and 4), comprising:*

a protocol converting controller (SMS/HTML Conversion and Control 40) that receives a first upstream mobile terminal message (MO Message) having a mobile terminal communication protocol and converts the first upstream mobile terminal message into a first upstream Internet message having an Internet protocol (Conversion to HTTP or HTML, column 6, lines 30-60),

wherein the first upstream mobile terminal message comprises a destination address (WWW identifier in the short message, column 3, lines 17-28; and column 7, lines 4-18), which corresponds to the mobile terminal communication protocol,

wherein the protocol converting controller receives the first upstream mobile terminal messages, selects a first upstream Internet address corresponding to the destination address of the first upstream mobile terminal message, and generates the first upstream Internet message based on the first upstream Internet address (Column 7, lines 4-28), and

wherein the first upstream Internet message is supplied to an Internet application (WWW server, column 3, lines 29-32).

2. (currently amended): *The communication system as claimed in claim 1, wherein the protocol converting controller receives a first downstream Internet message (WWW page) having the Internet protocol and converts the first downstream Internet message into a first downstream mobile terminal message having the mobile terminal communication protocol (Column 8, lines 22-33),*

wherein the first downstream Internet message is responsive to the first upstream Internet message (Retrieved WWW page is in response to the WWW page requested).

3. (original): *The communication system as claimed in claim 1, wherein the mobile terminal communication protocol is one of an SMS protocol and USSD protocol (SMS/HTML Conversion and Control 40).*

4. (original): *The communication system as claimed in claim 1, wherein the Internet protocol is one of an HTTP protocol and an XML protocol (Column 3, lines 5-16).*

22. (currently amended): *A communication method (Kotola, Figure 4), comprising:*

(a) receiving a first upstream mobile terminal message (MO Message) having a mobile terminal communication protocol, wherein the first upstream mobile terminal message comprises a destination address (WWW identifier in the short message, column 3, lines 17-28; and column 7, lines 4-18), which corresponds to the mobile terminal communication protocol; and

(b) converting the first upstream mobile terminal message into a first upstream Internet message having an Internet protocol (SMS/HTML Conversion and Control 40);

wherein the operation (b) comprises:

(b1) selecting a first upstream Internet address corresponding to the corresponding to the destination address of the first upstream mobile terminal message (Column 3, lines 17-28; and column 7, lines 4-18); and

(b2) generating the first upstream Internet message based on the first upstream Internet address (SMS/HTML Conversion and Control 40),

wherein the first upstream Internet message is supplied to an Internet application (WWW server, column 3, lines 29-32).

23. (original): The method as claimed in claim 22, further comprising:

(c) receiving a first downstream Internet message having the Internet protocol and converting the first downstream Internet message into a first downstream mobile terminal message having the mobile terminal communication protocol (Column 8, lines 22-33),

wherein the first downstream Internet message is responsive to the first upstream Internet message (Retrieved WWW page is in response to the WWW page requested).

24. (original): The method as claimed in claim 22, wherein the mobile terminal communication protocol is one of an SMS protocol and a USSD protocol (SMS/HTML Conversion and Control 40).

25.(original): The method as claimed in claim 22, wherein the Internet protocol is one of an HTTP protocol and an XML protocol (Column 3, lines 5-16).

Allowable Subject Matter

7. Claims 6-21, 32-37 and 39-42 are allowed over the prior art of record.

8. Claim 38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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9. Claims 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Marcelo whose telephone number is 571-272-3125. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melvin Marcelo
Primary Examiner
Art Unit 2662

January 4, 2005